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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,163	04/12/2007	Franciscus J Groenhof	118989-05154621	2012
20583	7590	09/08/2010	EXAMINER	
JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017		HOLLOMAN, NANNETTE		
		ART UNIT		PAPER NUMBER
		1612		
		MAIL DATE		DELIVERY MODE
		09/08/2010		PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/561,163	GROENHOF, FRANCISCUS J	
	<b>Examiner</b>	<b>Art Unit</b>	
	NANNETTE HOLLOWMAN	1612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 01 June 2010.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-18 and 20 is/are pending in the application.  
 4a) Of the above claim(s) 16-18 and 20 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-15 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/16/2005</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|   | 6) <input type="checkbox"/> Other: _____ .                        |

## DETAILED ACTION

### *Response to Election*

Applicant's election with traverse of Group I (claims 1-15) in the reply filed on June 1, 2010 is acknowledged. The traversal is on the ground(s) that under the PCT convention, national phase countries are required to examine the national application in compliance with the international examination. Furthermore, all the pending claims incorporate the same technical feature, i.e. at least one branched non-ionic surfactant and at least one surfactant capable of forming liquid crystals in water. Finally, as the polysaccharide combination in the prior art cited in not capable of forming liquid crystals. This is not found persuasive because where a group of inventions is claimed in a national stage application; the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. Consequently, as previously asserted, the technical feature of the instant claims fails to make a contribution over the art, since Dederen et al. (US Patent Pub. No. 2002/0065328) disclose a composition comprising at least one branched non-ionic surfactant and at least one surfactant capable of forming liquid crystals in water, i.e. the product at paragraph [0104], EM 13 Arlatone 2121, which is shown in the instant

specification as surfactant capable of forming a liquid crystals in water at p. 8, lines 6-11.

The requirement is still deemed proper and is therefore made FINAL.

In regard to new claim 20, it is dependent on claim 18, which is drawn to nonelected subject matter. Thus, claims 16-18 and 20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on June 1, 2010.

Claims 1-15 are being examined on the merits of the claims.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 8, the phrases "preferably" and "more preferably" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 8 recites the broad recitation "wherein q and r are each independently from 0 to 13" and "wherein  $q+r+p$  is in the range from 9 to 17", and the claim also recites "more preferably 2 to 13" ( $q$  and  $r$ ); and "preferably 10 to 16", and "more preferably 11 to 15" ( $q+r+p$ ), which are the narrower statements of the range/limitation.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 9-14 are rejected under 35 U.S.C. 102(b) as being anticipated by UNIQEMA® (Formulation data for W/O/W sunscreen, 2002, disclosed by Applicant).

UNIQEMA® discloses a formulation comprising sorbitan isostearate as a branched nonionic surfactant (Arlacel® 1690) and sorbitan stearate and sucrose cocoate (Arlatone® 2121), which is disclosed in the instant specification as capable of forming crystals in water at p. 8, lines 5-11 (Formulation). UNIQEMA® encompasses the limitations of the instant claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dederen et al. (US Pub. No. 2002/0065328).

Dederen et al. disclose a personal or cosmetic oil-in-water emulsion comprising a non-ionic emulsifier and particularly a combination of a low HLB and a high HLB emulsifier, wherein low HLB is less than about 8 and high HLB is more than about 12 (Abstract and p. 4, para. [0032]). Dederen et al. disclose non-ionic emulsifiers that meet the limitation of "one branched non-ionic surfactant" (instant claims 2-8), i.e. EM 15, Arlasolve ® 200- iso-cetyl alcohol 20 ethoxylate, and "surfactant capable of forming liquid crystals in water" (instant claims 9-14), i.e. EM 13, Arlatone ® 2121-mixture of sucrose cocoate and sorbitan stearate (p.9, para. [0106] and [0104]); which are shown in the compositions of TABLES 23b and 24.

Dederen et al. differ from the instant claims insofar as it does not disclose a preferred embodiment/example of a composition comprising at least one branched non-ionic surfactant and at least one surfactant capable of forming liquid crystals in water.

It would have been obvious to have used the at least one branched non-ionic surfactant and at least one surfactant capable of forming liquid crystals in water in the composition of Dederen, since the reference suggests using a combination of these surfactants as emulsifiers in the encompassed compositions.

***Conclusion***

No claim is allowed

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANNETTE HOLLOMAN whose telephone number is (571) 270-5231. The examiner can normally be reached on Mon-Fri 800am-500pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. H./  
Examiner, Art Unit 1612

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/Frederick Krass/

Supervisory Patent Examiner, Art Unit 1612